

U.S. Application Serial Nos. 08/926,194 and 08/926,246 as provided under 37 C.F.R. § 1.78(b). The Examiner also rejected claims 1 and 3-8 under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 5,314,187 to *Proudfit*. Claims 1 and 3-8 were also rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,314,187 to *Proudfit*.

As described further herein, Applicants present remarks concerning the present application and demonstrate that claims 1 and 3-8 are in condition for allowance.

A. Drawings

Applicants herewith submit the drawings referred to in the previous Response filed. Applicants regret any inconvenience to the Examiner.

B. The Submission of Copies of References Listed Within the Information Disclosure Statement Is Not Required for Those References to Be a Part of the Record Because the References are Previously Cited in Parent U.S. Application Serial Nos. 08/631,613, 08/542,793, and 08/070,510

Under 37 C.F.R. § 1.98(d), a copy of a patent, publication, or other information listed in an Information Disclosure Statement is not required to be provided if it was previously cited in a prior application. Here, the Information Disclosure Statement for U.S. Application Serial Nos. 08/631,613, 08/542,793, and 08/070,510, which are prior applications related to the present application, cite each of the patents disclosed in the Information Disclosure Statement for the present application. Therefore, Applicants are not required to submit copies of each of the references listed in the Information Disclosure Statement since they have been previously cited in a prior application. However, if the Examiner wishes Applicants to submit copies of such references, Applicants request the Examiner to so indicate.

C. The Examiner's Rejection of Claims 1 and 3-8 Under 35 U.S.C. § 112, Second Paragraph Has Been Overcome

The Examiner rejected claims 1 and 3-8 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserted that U.S. Application Serial Nos. 08/926,194 and 08/926,246, which the Examiner claimed are identical to the present application, do not depend from U.S. Application Serial No. 08/631,613, while

the present application depends upon U.S. Application Serial No. 08/631,613.

Applicants respectfully disagree with the Examiner's rejection. Applicants may choose the particular claim of priority for the present application, even if other applications similar to the present application contain different priority claims. Therefore, whether U.S. Application Serial Nos. 08/926,194 and 08/926,246 depend or do not depend on U.S. Application Serial No. 08/631,613, while the present application does, is no basis for a rejection under 35 U.S.C. § 112, second paragraph. Applicants submit that the rejection of claims 1 and 3-8 under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

D. The Provisional Rejection of Claims 1 and 3-8 Under 35 U.S.C. § 102(e) Is Only Relevant Once Either U.S. Application Serial No. 08/926,194 or 08/926,246 Has Issued as a U.S. Patent

The Examiner provisionally rejected claims 1 and 3-8 under 35 U.S.C. § 102(e) as anticipated by U.S. Application Serial Nos. 08/926,194 and 08/926,246.

Neither U.S. Application Serial No. 08/926,194 nor 08/926,246 has issued. A rejection under 35 U.S.C. § 102(e) requires the cited reference be "a *patent granted* on an application for a patent by another." Since no patent has been granted from the cited applications, it is premature for Applicants to address this provisional rejection until one of the cited applications issue.

E. The Examiner's Objections to Claims 1 and 3-8 Are Not in Conflict With Claims 1-8 of U.S. Application Serial Nos. 08/926,194 and 08/926,246

The Examiner asserted that claims 1 and 3-8 conflict with claims 1-8 of U.S. Application Serial Nos. 08/926,194 and 08/926,246. The Examiner also asserted that Applicants are required to either cancel conflicting claims from all but one application or maintain a clear line of demarcation under M.P.E.P. § 822.

Claim 1 of the present application and claim 1 of U.S. Application Serial Nos. 08/926,194 and 08/926,246 are different. Claim 1 of the present application recites the intermediate layer being formed of an ionomer base resin while neither U.S. Application Serial Nos. 08/926,194 nor 08/926,246 recite such a feature in claim 1.

Further, U.S. Application Serial Nos. 08/926,194 and 08/926,246 recite a claim 2 having an intermediate layer formed from a high repulsion ionomer base resin

whereas the present application does not even contain such a claim. The fact that claims 3-8 of U.S. Application Serial Nos. 08/926,194 and 08/926,246 and the present application are similar in language is irrelevant because claims 3-8 are dependent from claim 1 which, as shown above, is different in U.S. Application Serial Nos. 08/926,194 and 08/926,246 and the present application.

F. The Declaration Under 37 C.F.R. § 1.131 Prevents the Use of *Proudfit* as a Cited Reference Under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a)

Applicants now submit in the attached Declaration under 37 C.F.R. §1.131, that the subject matter sought to be patented was invented prior to the effective filing date of *Proudfit* ('187) of June 29, 1992. In support thereof, Applicants have attached to the enclosed Declaration, evidence which supports the declarative statement that the invention disclosed in the present application was completed prior to June 29, 1992.

Upon review of the file wrapper history of *Proudfit* parent application Serial No. 733,789 (filed July 26, 1991), it is apparent that the subject matter concerning multi-layer covers now being relied upon by the Examiner in his outstanding rejection was actually introduced into the second *Proudfit* application, Serial No. 905,895, filed on June 29, 1992. The filing date of the second or C-I-P application is less than one year prior to the effective filing date of the present application of June 1, 1993 and it is long after Applicant's invention date.

As a result, the effective filing date for the *Proudfit* ('187), insofar as *Proudfit* is being relied upon by the Examiner, is June 29, 1992. This is less than one year prior to the effective filing date of June 1, 1993 of the present application. Hence, Applicants can now establish, through the enclosed Declaration under 37 C.F.R. §1.131, that Applicants have reduced the invention of the present application to practice prior to the effective filing date of *Proudfit* ('187) of June 29, 1992.

Along these lines, 37 C.F.R. §1.131 allows the removal of a reference as prior art through the submission of an Affidavit or Declaration showing that the Applicant had previously reduced the invention to practice before the effective filing date of the application which resulted in the prior art reference if the prior art reference has an effective filing date of less than one year prior to the filing date of the pending application. If this occurs, the reference can be removed as prior art by the Applicant

showing that he has already actually reduced the invention to practice in the U.S. before the filing date of the referenced patent.

The Declaration under 37 C.F.R. §1.131 states that Michael J. Sullivan, completed the invention of the present application, in this country, prior to June 29, 1992. In support thereof, evidence of reduction to practice of the present invention is provided as shown in the attached Tables 1 and 2. In view of the Declaration and evidentiary support included therewith, Applicants submit that the *Proudfit* U.S. Patent No. 5,314,187 no longer qualifies as "prior art" under either 35 U.S.C. § 102(a) or 35 U.S.C. §103(a). As such, Applicants respectfully request withdrawal of the rejection of claims 1-8 under 35 U.S.C. § 102 and 35 U.S.C. §103 over *Proudfit* ('187).

Please note that the present Declaration is a copy of one submitted in a prior application. If the Examiner would like another Declaration specific for the present application, Applicants will submit such a Declaration.

G. The Examiner's Rejection of Claims 1 and 3-8 Under 35 U.S.C. § 102(a) As Being Anticipated by *Proudfit* Has Been Overcome

The Examiner rejected claims 1 and 3-8 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,314,187 to *Proudfit*. Specifically, the Examiner stated in the Office Action that "inherent features of the golf ball are claimed." (Office Action, p. 4.) Notwithstanding the submission of the Declaration under 37 C.F.R. § 1.131 by Applicant, Applicants set forth the following remarks overcoming the Examiner's rejection under 35 U.S.C. § 102(a).

Claim 1 of the present application recites an intermediate layer of a golf ball having a specific gravity of less than 1.2 and a Shore C hardness of at least 85. *Proudfit* does not disclose a Shore C hardness or specific gravity for any layer let alone the intermediate layer. More particularly, *Proudfit* neither discloses nor teaches the specific Shore C hardness and specific gravity values as recited in claim 1 for either the intermediate layer or center core. Therefore, claim 1 is not anticipated by *Proudfit*.

Since claims 3-8 depend from claim 1, and claims 3-8 recite additional features than claim 1, claims 3-8 are also not anticipated by *Proudfit*.

**H. The Examiner's Rejection of Claims 1 and 3-8 Under 35 U.S.C. § 103(a)
As Being Obvious in Light of *Proudfit* Has Been Overcome**

The Examiner rejected claims 1 and 3-8 under 35 U.S.C. § 103(a) as being obvious in light of *Proudfit*. The Examiner stated that “[a]ny possible distinctions over *Proudfit* golf balls are deemed obvious arbitrary variants thereof simply to provide additional comparative examples.” (Office Action, p. 4.) Notwithstanding the submission of the Declaration under 37 C.F.R. § 1.131, Applicants set forth the following arguments overcoming the Examiner's rejection under 35 U.S.C. § 103(a).

Claim 1 of the present application recites an intermediate layer having a specific gravity of less than 1.2 and a Shore C hardness of at least 85. Further, claim 1 recites a center core with a specific gravity of less than 1.4.

Proudfit neither teaches nor suggests a specific gravity or Shore C hardness for any layer. Moreover, *Proudfit* neither teaches nor suggests the important benefits of specific gravity and Shore C hardness as recited in claim 1. Thus, the features recited in claim 1 are not obvious in light of *Proudfit*.

Claims 3-8, which are dependent from claim 1 of the present application, are also not obvious in light of *Proudfit* since claims 3-8 recite additional features than claim 1.

CONCLUSION

In view of the foregoing, it is believed that claims 1 and 3-8 are in condition for allowance. Therefore, the Applicants respectfully request favorable reconsideration and allowance of this application.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT AND RESPONSE UNDER 37 C.F.R. 1.115** in connection with U.S. Patent Application Serial No. **08/926,872** is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on December 14, 1999.

By:

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